PATENT
PD-Y00-044

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Appeal No. _____

In re Application of: MICHAEL D. BULLOCK ET AL.
Serial No.: 09/735,002
Filed: December 12, 2000
For: PRACTICE PUTTER AND HEAD

APPELLANTS' BRIEF ON APPEAL

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In re Application of: MICHAEL D. BULLOCK ET AL	:	Date: March 2, 2005
Serial No.: 09/735,002	:	
Filed: December 12, 2000	:	Group Art Unit: 3711
For: PRACTICE PUTTER AND HEAD	:	
	:	Examiner: Thanh P. Duong

APPELLANT'S BRIEF ON APPEAL

Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

This is Appellants' brief on appeal from the decision of the Examiner in the Office Action dated November 24, 2004 finally rejecting Claims 1-7, 9-15, and 17-19 in the above-identified patent application. This brief is submitted in accordance with the provisions of 37 C.F.R. §1.192.

REAL PARTY IN INTEREST

The real parties in interest are the inventors, Michael D. Bullock and Jeffrey G. Bullock.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellants, appellant's legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-7, 9-15, and 17-19 are currently pending in this application and were finally rejected in the Office Action dated November 24, 2004. Appellant appeals from this final rejection.

STATUS OF AMENDMENTS

With regard to the status of amendments, six Office Actions were issued during prosecution of this application. No claim amendments were made in response to the final Office Action dated November 24, 2004. The Claims as they currently stand are presented in the Appendix.

SUMMARY OF INVENTION

The present invention provides for a putter (10) and putter head (20) for use during putting practice. The practice putter(10) is used to improve a golfer's ability to contact a golf

ball on the sweet spot of the putter. The practice putter (10) has a grip (12) and a shaft (11) as in conventional putters. The shaft (11) is connected to a putter head (20) that is specifically designed to be use during practice and that has a design the will improve the golfer's ability to contact the golf ball on the sweet spot of the putter head.

The putter head (20) has a generally flat base (11) with an upwardly extending front surface having a relatively small, centrally-located, flat ball contact surface (23) that comprises the sweet spot of the putter head (20). The remainder of the front surface of the putter head (20) tapers away from the flat ball contact surface (23) toward the rear of the putter head (20). The tapered portions of the front surface, or ball contact surface (23) of the putter head may be flat or curved, but in any event are angled with respect to a normal to the flat ball contact surface (23).

An exemplary putter head (20) has lateral portions (24) that are relatively thick that each have openings (26, 26a) formed therein that receive the shaft (11). Thus, the practice putter (10) may be made so that it is either left or right handed. The rear portion of the exemplary putter head has a cavity (27) formed therein that reduces the overall weight of the putter head (20).

ISSUES

There are three issues in this appeal which are as follows.

The first issue is whether Claim 19 is anticipated under 35 U.S.C. § 102(b) by US Design Patent No. D226,526 issued to Cicero.

The second issue is whether Claim 18 is obvious in view of US Design Patent No. D226,526 issued to Cicero.

The third issue is whether Claims 1-7, 9-15, and 17 are unpatentable under 35 U.S.C. 103(a) over US Design Patent No. D282,952 issued to Mattingly in view of US Patent No. 5,769,737 issued to Holladay et al. and US Design Patent No. D234,962 issued to Swash.

GROUPING OF CLAIMS

With regard to the specific grounds of rejection that are in issue with regard to Claims 1-7, 9-15, and 17, it is respectfully submitted that Claims 1-7, 9-15, and 17 stand or fall together.

ARGUMENT

The first issue is whether Claim 19 is anticipated under 35 U.S.C. § 102(b) by US Design Patent No. D226,526 issued to Cicero. It is respectfully submitted that the Examiner's rejection of Claim 19 is in error.

The Cicero design patent shows a top plan view, a side elevation view showing the front striking surface at the left, and front and bottom plan views, respectively, of a golf putter head. No shaft or grip is disclosed or suggested by the Cicero design patent. The front elevation view illustrated in Fig. 1 show that the ball contact surface is flat along substantially the entire front

surface of the putter head, except for two forwardly-projecting ends or wings that extend a short distance in front of the ball contact surface. The two forwardly projecting ends of the putter head have front edges that are curved surfaces as is shown in the side elevation view illustrated in Fig. 2. The putter head is solid and has no cavities therein, although there is a hole in top of the rear portion where it appears that a shaft may be inserted. The top surface of the front portion of the putter head is higher than the rear portion and has an alignment groove cut in it along the centerline of the putter head.

The Examiner's position is that "Cicero discloses a putter head (Fig. 1) comprising: a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending "substantially" the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface." It is respectfully submitted that this is clearly not what is shown in the drawing figures of the Cicero design patent.

Claim 19 calls for a putter head comprising:

"a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface."

As was stated above, the front surface (ball contact surface) of the Cicero putter head is essentially flat and extends almost the entire height and width of the putter head, except for the forwardly-projecting ends. Therefore, it is respectfully submitted that the Cicero design patent does not disclose or suggest "a front surface with a relatively small, centrally-located, flat ball contact surface ... that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width" as is recited in Claim 19. It is respectfully submitted that the Cicero design patent clearly does not disclose or suggest a putter head having a ball contact surface that is about 5/8 to 1/2 inches in width.

Furthermore, the front surface of the Cicero putter head does not "taper rearwardly away from the ball contact surface" as is recited in Claim 19. It is respectfully submitted that while the Cicero design patent discloses that forwardly projecting ends of the putter head have front edges that are curved surfaces, the curved surface are located in front of the ball contact surface and do not taper rearwardly away from the ball contact surface. In fact, the curved surfaces are in front of and taper toward the ball contact surface. [Emphasis added]

Therefore, with specific regard to Claim 19, it is respectfully submitted that the Cicero patent does not disclose or suggest a putter head having "a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface".

Therefore, and in view of the above arguments, it is respectfully submitted that Claim 19 is not anticipated by the Cicero design patent. Accordingly, reversal of the Examiner's rejection and allowance of Claims 19 are respectfully requested.

The second issue is whether Claim 18 is obvious in view of US Design Patent No. D226,526 issued to Cicero. It is respectfully submitted that the Examiner's rejection of Claim 18 is in error.

It is respectfully submitted that the arguments made above with respect to Claim 19 support the allowability of Claim 18 over the Cicero design patent. In particular, and in view of the arguments made with regard to Claim 19 above, it is respectfully submitted that the Cicero design patent does not disclose or suggest a putter head having "a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width" or a putter head having a ball contact surface whose lateral portions "taper rearwardly away from the ball contact surface". Furthermore, it is respectfully submitted that the Cicero patent does not disclose or suggest "a shaft having a grip disposed at an upper end" as is recited in Claim 18. While Fig. 1 of the Cicero design patent shows a hole in top of the rear portion where it appears that a shaft may be inserted, there is no shaft or grip shown in the Cicero design patent.

In view of the above, it is respectfully submitted that Claim 18 is not obvious in view of the Cicero design patent. Accordingly, reversal of the Examiner's rejection and allowance of Claim 18 are respectfully requested.

The third issue is whether Claims 1-7, 9-15, and 17 are unpatentable under 35 U.S.C. § 103(a) over US Design Patent No. D282,952 issued to Mattingly in view of US Patent No. 5,769,737 issued to Holladay et al. and US Design Patent No. D234,962 issued to Swash. It is respectfully submitted that the Examiner's rejection of Claims 1-7, 9-15, and 17 is in error.

The Mattingly design patent shows a front elevational view, a top plan view, a rear elevational view, a side elevational view and a perspective view, respectively, of a golf putter head. The Mattingly design patent shows that the golf putter head is solid and has no cavities therein, although there is a hole in top of the rear portion where it appears that a shaft may be inserted. No shaft or grip is disclosed or suggested by the Mattingly design patent.

The Holladay et al. patent discloses (in its Abstract, for example) a "golf club head, and particularly a putter head, having a generally horizontally disposed weight receiving cavity which extends longitudinally and laterally within the club head, and one or more weight members having weight securing means to releasably attach the weight members within the weight receiving cavity at any position laterally or longitudinally within the weight receiving cavity." The ball "striking face 11" of the Holladay et al. golf club head is shown to be flat and extends the entire width of the putter head. Column 3, lines 45-51 mentions that "the club head 10 is configured with a relatively large surface cavity 17 cut into the top surface 15 and/or rear wall 12."

The Swash design patent shows a front view of a golf club head, a plan view of a right handed golf club head, a plan view of a left handed golf club head, a rear view of a right handed golf club head, a rear view of a left handed golf club head, two cross-sectional views of the golf club head, and perspective views of right and left handed golf club heads. The Swash design patent shows that there is a hole at a side of the head where it appears that a shaft may be inserted. No shaft or grip is disclosed or suggested by the Swash design patent. The ball contact surface of the Swash golf club head is entirely flat and extends the entire width of the head. There appears to be two shallow trapezoidal cutouts or cavities formed in the interior portion of the top surface of the golf club head. The cutouts are formed lateral to an alignment ridge or surface extending along the top centerline of the putter head. The base appears to be flat at the front of the head and tapers upwardly toward the rear of the head, as is shown in Fig. 6.

It is respectfully submitted that neither the Swash design patent nor the Holladay et al. patent discloses or suggests a putter head having a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head, or lateral portions that taper rearwardly away from the ball contact surface. Both the Swash design patent and Holladay et al. patent disclose putters that are intended for use in a round of golf, and not practice putters.

The Examiner's position is that "Mattingly '952 discloses a putter head comprising: a single, solid, a trapezoidal unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface a base extending toward a rear end of the body." The Examiner admitted that " Mattingly does not disclose a rear portion of the putter head has a cavity" but that the Holladay et al. patent teaches this, and that "Swash '962 also teaches rear portion having a cavity to reduce the overall weight of the putter head."

As was stated above, it is respectfully submitted that the Mattingly design patent discloses a putter head that is solid with no cavities. The Mattingly putter head has a stepped (raised) upper surface having a triangular shape. The Mattingly putter head has a raised rear edge that extends above the top surface of the raised upper triangular shaped surface, and a raised alignment surface extending along the centerline of the head that is at the same height as the raised rear edge.

It is respectfully submitted that one skilled in the art would not modify the Mattingly putter to add a cavity as recited in Claim 1, for example, and certainly not without using hindsight reconstruction. The Mattingly putter head does not have a cavity, and there is no disclosure or suggestion in the Mattingly design patent that it would be desirable to have one. It is respectfully submitted that any modification of the Mattingly putter head to include a cavity is based upon the use of hindsight reconstruction.

It is respectfully submitted that the Mattingly design patent shows a putter head that is essentially a solid trapezoidal head with no cavities other than what appears to be a hole for a

shaft. The ball contact surface of the Mattingly putter head is at least, and appears to be more than, 1/3 the width of the front of the putter head, which is shown in Figs. 1, 2 and 5. It is respectfully submitted that this is not a "relatively small" ball contact surface, it is a relatively large one, at least when compared to the size of the ball contact surface of the present invention. The reason that this is so is that the Mattingly putter head is designed to be used with a putter that is used during a golf round, whereas the present invention is designed as a practice putter. With regard to the present invention, the idea is to practice with a putter having a small contact area so that the stroke becomes more accurate, and then use a regular putter with a relatively large contact surface during a golf round. This is also true of the Swash putter head.

There is no disclosure or suggestion in the Mattingly design patent that a cavity would be desirable. In fact, the top surface of the Mattingly putter head is configured to have a raised triangular area that tapers parallel to respective sides of the head and a raised alignment line that extends above the main body of the head and the raised triangular area. Therefore, it is respectfully submitted that the Mattingly putter head would not be modified to add a cavity to it, particularly because this would eliminate the raised alignment line. Also, adding a cavity to the Mattingly putter head teaches away from the express teachings of the Mattingly design patent.

Consequently, notwithstanding the fact that the Holladay et al. and Swash patents disclose various types of cavities, it is respectfully submitted that the Mattingly putter head would not be modified to include such cavities without the use of hindsight reconstruction. It is stated in the Holladay et al. patent at column 3, lines 45-51 that "In the preferred embodiment for a putter, and especially for a blade putter as shown in the figures, the club head 10 is configured with a relatively large surface cavity 17 cut into the top surface 15 and/or rear wall 12. This structure removes unnecessary weight from the club head 10 and gives the club head 10 an inverted F-shape when taken in cross-section, as shown in FIG. 3."

As was argued above, adding such a cavity to the Mattingly putter head would eliminate specifically claimed features thereof and also distort the design of the Mattingly putter head as taught by the Mattingly design patent, namely the raised triangular surface and the center alignment ridge. More particularly, adding a relatively large surface cavity cut into the top surface and/or rear wall as taught by the Holladay et al. patent to the Mattingly putter head would completely eliminate the raised triangular surface and the center alignment ridge. It is respectfully submitted that this totally distorts the teachings of the Mattingly design patent.

Also adding two trapezoidal cavities as taught by the Swash design patent would eliminate or remove the raised triangular surface of the Mattingly putter head. Furthermore, it is respectfully submitted that one skilled in the art would not attempt to add the trapezoidally shaped cavities taught by the Swash design patent to the Mattingly putter head. The edges of the trapezoidally shaped cavities taught by the Swash design patent are essentially parallel to front, side and rear edges of the putter head, and define the lateral edges of the alignment surface. Adding these trapezoidally shaped cavities to the Mattingly putter head would not produce a structure that conforms to the teachings of the Swash design patent. Thus, the

trapezoidally shaped cavities would necessarily need to be modified or adapted to fit the shape of the Mattingly putter head. It is respectfully submitted that there is no disclosure or suggestion in either the Mattingly or Swash patents that would provide for this.

The Mattingly design patent does not disclose or suggest a putter head having a base extending toward a rear end of the body with a cavity formed behind the ball contact surface and lateral portions and above the base. There is no "base" as taught in the present application disclosed or suggested in the Mattingly design patent. The Mattingly putter head is designed such that the height of the body is more-or-less the same along the entire length and width of the head (except for the raised triangular area and alignment line and the back top edge of the head. It is respectfully submitted that adding a cavity to the Mattingly putter head amounts to hindsight reconstruction by distorting the express teachings of the Mattingly design patent and combining features not disclosed therein that are taught in the Holladay et al. and Swash patents using the teachings of the present application.

More specifically, the triangular portion of the top surface of the Mattingly putter head is raised above the level of the remainder of the top surface of the putter head, the alignment line along the top center line of the head is raised above the level of the triangular portion, and the raised back edge is at the level of the alignment line. It is respectfully submitted that one skilled in the art would not eliminate these expressly disclosed features of the Mattingly design patent by adding a cavity behind the ball contact surface without using hindsight reconstruction based upon the teachings of the present invention.

The Examiner argued that "Holliday '737 teaches the large surface cavity 17 removes unnecessary weight from the club head 10 to reduce weight of the putter head (Col. 3, lines 44-50). Swash '962 also teaches rear portion having a cavity to reduce the overall weight of the putter head." It is respectfully submitted that there is no teaching or suggestion contained in the Mattingly design patent that it would be desirable to remove weight from the putter head. The design of the Mattingly putter head provides for a solid body without a cavity so that the top surface can have the alignment feature on it that extends to the back edge of the head. Adding a cavity to the Mattingly putter head would clearly eliminate this expressly disclosed feature from the Mattingly putter head. It is respectfully submitted that this would not be done by one skilled in the art absent hindsight reconstruction. Also, the cavities disclosed in the Swash and Holladay et al. patents are not suitable for use in the Mattingly putter head without modifying the cavities or distorting this Mattingly putter head. It is respectfully submitted that this would not be done absent the use of hindsight reconstruction.

It is again respectfully submitted that there is no disclosure or suggestion contained in the cited patents that would provide for their combination. This is derived using hindsight reconstruction by the Examiner, using the teachings of the cited patents in light of the teachings of the present application. The Mattingly design patent teaches away from what is disclosed in the Holladay et al. patent and Swash design patent, since neither of the secondary references disclose or suggest front surfaces that taper outwardly and rearwardly, and the shapes of the

putter heads are entirely different. Again, none of the cited patents disclose or suggest a practice putter head as is taught in the present application.

With specific regard to Claim 1, it is respectfully submitted that the Mattingly design patent, in combination with the Holladay et al. patent and Swash design patent, taken singly or together, do not disclose or suggest a putter comprising a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface, a base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the base," without using hindsight reconstruction. It is respectfully submitted that hindsight reconstruction, along with distortion and modification of the express teachings of the cited references is required to produce the invention recited in Claim 1.

Therefore, and in view of the above, it is respectfully submitted that the Mattingly design patent, in combination with the Holladay et al. patent and Swash design patent, taken singly or together, do not disclose or suggest a putter as recited in Claim 1, and certainly not without distorting the express teachings of the cited references and using hindsight reconstruction. Accordingly, reversal of the Examiner's rejection and allowance of Claim 1 are respectfully requested.

Independent Claims 9 and 17 recite substantially the same subject matter as is recited in Claim 1. Therefore, it is respectfully submitted that the subject matter recited in Claims 9 and 17 are not disclosed or suggested by the Mattingly design patent in combination with the teachings of the Holladay et al. patent and Swash design patent, taken singly or together, without the use of hindsight reconstruction. Therefore, reversal of the Examiner's rejection and allowance of Claims 9 and 17 are respectfully requested.

With regard to the pending dependent Claims, Claims 3 and 11 call for a putter "wherein the shaft has an offset." It is respectfully submitted that none of the cited patents disclose or suggest anything regarding the use of an offset shaft. The Mattingly and Swash design patents do not disclose or suggest any type of shaft, only putter heads are disclosed. The Holladay et al. patent shows a portion of a straight shaft in Figs 1 and 2. This shaft is not an "offset shaft" known to those skilled in the art.

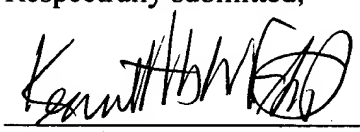
With regard to Claims 6 and 14 call for a putter head "wherein the lateral portions of the front surface are curved surfaces." It is respectfully submitted that there is no disclosure or suggestion in any of the cited patents regarding a putter head whose lateral portions are curved surfaces. The Mattingly design patent only shows flat lateral surfaces, the Holladay et al. and Swash design patents do not disclose or suggest any tapered lateral surfaces.

Claims 2-7 and 10-15 are considered patentable based upon the allowability of Claims 1 and 9 from which they depend. Therefore, it is respectfully submitted that the invention recited in Claims 2-7 and 10-15 are not disclosed or suggested by the Mattingly design patent, Holladay et al. patent and Swash design patent, taken singly or together, without the use of

hindsight reconstruction. Accordingly, reversal of the Examiner's rejection and allowance of Claims 1-7, 9-15, and 17 are respectfully requested.

In view of the above, it is respectfully submitted that Claims 1-7, 9-15, and 17-19 are not obvious in view of the cited patents, taken singly or in combination, and are therefore patentable. Therefore, it is respectfully submitted that the rejection of Claims 1-7, 9-15, and 17-19 by the Examiner was erroneous, and reversal of the Examiner's decision is respectfully requested.

Respectfully submitted,



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APPENDIX

The Claims presented below are currently pending in this application.

1. A putter comprising:
a shaft having a grip disposed at an upper end;
a putter head disposed at a lower end of the shaft that comprises:
a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface, a base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the base.

2. The putter recited in Claim 1 wherein the shaft is straight.

3. The putter recited in Claim 1 wherein the shaft has an offset.

4. The putter recited in Claim 1 wherein the body has a trapezoidal shape.

5. The putter recited in Claim 1 wherein the lateral portions of the front surface are flat surfaces.

6. The putter recited in Claim 1 wherein the lateral portions of the front surface are curved surfaces.

7. The putter recited in Claim 1 wherein the putter head has a flat base with relatively thick lateral ends, one of which has an opening therein into which the shaft is inserted.

8. (Canceled)

9. In a putter having a shaft with a grip disposed at an upper end and a putter head disposed at a lower end, wherein the putter head comprises:
a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface, a base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the base.

10. The putter head recited in Claim 9 wherein the shaft is straight.

11. The putter head recited in Claim 9 wherein the shaft has an offset.

12. The putter head recited in Claim 9 wherein the body has a trapezoidal shape.

13. The putter head recited in Claim 9 wherein the lateral portions of the front surface are flat surfaces.

14. The putter head recited in Claim 9 wherein the lateral portions of the front surface are curved surfaces.

15. The putter head recited in Claim 9 which has a flat base with relatively thick lateral ends, one of which has an opening therein into which the shaft is inserted.

16. (Canceled)

17. A putter comprising:

a shaft having a grip disposed at an upper end;

a putter head disposed at a lower end of the shaft that comprises:

a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface from respective lateral edges of the ball contact surface to respective outer edges of the putter head, a base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the base.

18. A putter comprising:

a shaft having a grip disposed at an upper end;

a putter head disposed at a lower end of the shaft that comprises:

a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface.

19. A putter head comprising:

a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface.